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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,316	01/18/2002	Alfred Thomas	2100/17	8018

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EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/051,316

Applicant(s)

THOMAS ET AL.

Examiner

Robert Mosser

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 1st, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-47, 49-80, 82-103, and 112-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 112 and 113 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 13, 23-35, 56 and 89 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION



Responsive to the amendment filed March 1st, 2005.

This action is Final.

Claims 1, 3-47, 49-80, 82-103, and 112-114 are pending.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 3-12, 15-21, 41, 44-47, 49-56, 58-72, 78-80, 82-88, 91-98, 100-101** and **103** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Webb** (6,336,860) in view of **Paulsen** (6,609,978).

Comments presented under the heading "Response to Arguments" below are incorporated herein.

Regarding claims **1, 41, 47, 49, and 64**, Webb teaches a method of operating a gaming machine, that comprises the steps of: providing a first game of chance (1st row in multi-hand poker or a symbol color) which concludes in a final outcome; providing a second game of chance {2nd row in multi-hand poker or a symbol shape} which has the potential on every play for achieving a prize award; placing a wager; operating said first game of chance; operating said second game of chance in conjunction with the first game of chance {both 1st and 2nd rows are played at the same time- concurrently- and the game characters in the character embodiment are shown with both their shape and color in Webb}; awarding any prize achieved in the second game of chance (Col 6:49-7:67). While Webb teaches the feature of prize awards, Webb lacks the explicit teaching of the prizes being non-monetary. In an analogous electronic slot gaming machine that includes slot games and simulated card games, Paulsen teaches the feature of prize awards that are only non-monetary (abstract; Fig. 1; col. 3, lines 27-30; col. 1, lines 33-39 and lines 50-57; col. 2, lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the non-monetary prize feature, as taught by Paulsen, as the prize award feature in the second game of Webb to provide more desirable gaming opportunities for players that are more attracted to games with non-monetary prizes or alternatively for game operators in jurisdictions that might restrict the prizes to non-monetary prizes, according to the gaming rules of those jurisdiction.

Regarding claims **3-6**, and **58-61**, Webb and Paulsen teach all the limitations of the claims as discussed above. Paulsen further teaches that the prizes could be tangible goods and services (col. 5, lines 23-32). Paulsen is silent regarding the explicit disclosure of point values. However, it is well known in the art to award players points values that are credits that can redeemed during a next play of the game or at various other times (in the form of tickets, vouchers, etc.). Further, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate prize points in Paulsen to further enhance the player's gaming experience through allowing the convenient management of their winnings until they wish to receive them or have concluded play..

Regarding claims **7-9**, **12**, and **15-19**, Webb and Paulsen teach all the limitations of the claims as discussed above. Webb further teaches a plurality of different card/symbol indicia {interpreted as prize indicia by the examiner because combinations of the card/symbol indicia determine the prize (payout) awarded to the player} for the second game of chance, a preset number of card indicia {five cards} being displayed in the course of the second game through a random selection, and said prize award is achieved through a predetermined association of the card indicia {prizes or payouts are awarded in Webb according to a predetermined combination of the card indicia} (abstract; col. 4, lines 35-55). Further, Paulsen teaches a plurality of non-monetary prize awards (abstract).

Regarding claims **10-11**, **50-56**, and **65-71**, Webb and Paulsen teach all the limitations of the claims as discussed above. Webb further teaches that the indicia of

Art Unit: 3713

the first and second game of chance are displayed in a like number to each other {five indicia are displayed for both the 1st and 2nd hand} in at least column 7, lines 36-48.

Regarding claims **20**, **62**, and **72**, Webb and Paulsen teach all the limitations of the claims as discussed above. While Webb teaches a third game (Col 7:35-8:12) {a third hand or equivalent row}, Webb is silent regarding the explicit disclosure of this game as a bonus game. Webb also lacks the explicit disclosure of the bonus game being won as one of the prizes from the second game. However, the examiner asserts that bonus games are well known in the art. Further, it is well known in the art to “award” players with a bonus game for achieving certain ideal outcomes in a base game. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ these features in Webb and Paulsen to provide increased popularity for continued play of the gaming device; thereby providing increased profits to the gaming establishment.

Regarding claims **21**, and **63**, Webb and Paulsen teach all the limitations of the claims as discussed above. The references are silent regarding the use of a player tracking system. However, the examiner takes notice that it is well known in the art to employ player tracking systems as a means of tracking players and awarding valuable players {those that frequent the gaming establishment and/or spend large sums of money on the gaming machines}. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include player tracking in Webb and Paulsen as an incentive for a player to play the second game {second hand of Webb} to increase play at the gaming machine.

Regarding claims **44-46**, Webb and Paulsen teach all the limitations of the claims as discussed above. Paulsen further teaches the delivery of coupons, vouchers or other entitlement papers for the prizes (col. 5, lines 28-32). Paulsen is silent regarding the use of a printer to deliver the coupons, etc. It is well known in gaming arts to print out slips with gaming credits for players to redeem at a cashier's station or other place within the gaming establishment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of a printer in Paulsen to provide an easy, convenient means for players to receive game credits.

Regarding claims **78-80, 82-88, 91-98, 100-101, and 103**, Webb and Paulsen teach all the limitations of the claims as explained in detail in reference to similar claims, above.

Claim **102** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Webb** (6,336,860) in view of **Paulsen** (6,609,978), further in view of **Hughes-Baird** et al (6,468,156).

Webb and Paulsen teach all the limitations of the claims as discussed above. The references are silent regarding a bonus payout table. However, in an analogous gaming device, Hughes-Baird teaches a bonus pay schedule Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ a bonus pay schedule, as taught by Hughes-Baird in Webb and Paulsen to increase the player's chances of winning additional money thereby increasing play at the gaming device.

Claims **14, 36-39, 57, 73-77, 90, 99** and **114** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Webb** (6,336,860) in view of **Paulsen** (6,609,978), further in view of **Yoseloff** et al (6,311,976).

Webb and Paulsen teach all the limitations of the claims as discussed above. While Webb and Paulsen teach slot gaming devices, the references lack the explicit disclosure of the devices having a reel display. In an analogous slot gaming device, Yoseloff teaches the use of reel slot machines in a video gaming environment (col. 1, lines 40-48). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include reels in Webb and Paulsen to make the game more realistic and exciting by simulating the reels of original, mechanical slot machines.

Claims **22, 40, and 42-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Webb** (6,336,860) in view of **Paulsen** (6,609,978), further in view of **Meekins** et al (6,685,563).

Regarding claim **22**, Webb and Paulsen teach all the limitations of the claim as discussed above. While Webb teaches the feature of placing a wager for a first and second game {1st and 2nd hands} (abstract, Col 5:10-18, Col 6:14-26), Webb is silent regarding the feature of the wager for the second game being greater in value than the wager for the first game. In an analogous gaming device, Meekins teaches the feature of a greater threshold wager being required for the player to play a second game {bonus game} than that required to play the first game (col. 2, lines 4-10 and lines 41-50). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to include this feature of Meekins in the gaming devices of Webb and Paulsen to increase revenues to the casinos and wagering establishments.

Regarding claims **40** and **42**, Webb and Paulsen teach all the limitations of the claims as discussed above. While Webb teaches the play of the first and second game with a wager for each, Webb is silent regarding play of the second game if the wager is of a preset amount. Meekins teaches this feature as discussed above. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Meekins in the gaming devices of Webb and Paulsen to increase revenues to the casinos and wagering establishments.

Regarding claim **43**, Webb, Paulsen and Meekins teach all the limitations of the claims as discussed above. Paulsen further includes the use of a card to place a wager (Fig. 4B, #414e; col. 3, lines 19-21). It would have been obvious to a person of ordinary skill in the art at the time of the invention for further enhance Paulsen to include requiring the player to place a preset wager on the card to promote the use of a card as the means for wagering; this would decrease the amount of maintenance needed for the machine for refilling and unloading coins; thereby making it easier for the gaming establishment to maintain the machines. Further, the use of cards makes it more convenient for the establishment to provide player tracking and award comps to frequent players, which is a well known feature in the gaming art.

Allowable Subject Matter

Claims **112-113** are allowed.

Claims 13, 23-35, 56, and 89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for the indication of allowable subject matter can be found in the previous office action (paper #9, 12/3/03), which is incorporated herein by reference.

Response to Arguments

Applicant's arguments filed March 1st, 2005 have been fully considered but they are not persuasive.

Applicant challenges Webb for the presentation of a first and second game starting on page 17 of remarks by applicant. Applicant states "The matrix of Webb does not equate to a first game of chance and a second game of chance" and further presents that each ach line of Webb defines a mode of play (i.e. single line, multi-line, etc.) of a single game of chance. The applicant proceeds to multiple citations within the Webb reference to which they believe support their position.

Upon review of the applicant's arguments they have been found to fail on the following points:

a) As referenced in the previously rejection Webb (Col 6:49-67) teaches the display game elements with multiple components of a color and symbol, the evaluation of a plurality of game elements according to a first set of criteria (when all symbols are the same irrespective of color) and the a second evaluation of game elements according to a second set of criteria (when all colors are the same irrespective of

symbols). Applicant has failed to address the portion of the reference cited and instead challenged portions not relied upon in the rejection. As set forth above and as originally presented the above demonstrates two distinct game outcomes "irrespective" of each other.

b) The applicant challenges based on "single game of chance" (last paragraph of page 17) points to Webb column 8 lines 33-35 for support. The position fails for two reason. The first reason is immediately preceding the provided excerpt Webb prefaces the cited reference with "numerous games and wagering opportunities can be provided for added excitement to a casino game of chance" (Col 8:26-29) and thereby establishes the equation of a game encompassing multiple sub-games. Second the dissolution of a singular game aspect into portions at the very least presents an issue of nomenclature and at the very best might be equated to multi-line wagering on a multi-line slot machine wherein each distinct non-overlapping line would represent a singular game of chance distinct from one another.

c) Issues surrounding the "first game of chance" and the "second game of chance" fail in kind under the establishment of multiple game outcomes irrespective of one another provided for under section a) above through Webb. Additional delineations between the system and method of Webb and the instant claimed inventions are not supported in the claims as presented and as such will not be addressed.

For the reason stated above the application and correspondence of Webb are believed to be clarified and affirmed in view of comments by applicant.

Applicant further challenges the combination of Webb and Paulsen under the proposition that Webb contains a destructive teaching for the incorporation of a non-monetary prize such as the one taught by Paulsen and further that there exists no motivation for the adaptation of Webb in view of Paulsen.

While the examiner agrees that Webb only teaches the awarding of monetary prizes, there is no cited or otherwise provided reference within the Webb reference that would teach away from the utilization of a non-monetary prize. The omission of this feature does not provide a destructive teaching. According to this feature has been provided for through Paulsen. Further the examiner has provided the previously presented motivation for the combination of the feature with the invention of Webb which the applicant has not addressed and therefore remains unchallenged. It is additionally noted that both the device and method of Webb are in a similar field of endeavor, as they both address the field of electronic based gaming and both incorporate features directed to the delivery of a prize (albeit of different form) to a player. As such it the modification of the gaming invention of Webb with features provided for by another gaming invention such as the one provided for by Paulsen are maintained as to have been obvious to one of ordinary skill in the art of electronic gaming at the time of claimed invention.

Remaining arguments are premised on the issues addressed above and therefore fail in kind for their reliance on the addressed issues.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM


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TC3702